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Remarks

This paper is submitted in reply to the Advisory Action dated April 16, 2004, within the one-month period for response. The Advisory Action indicated that the Amendment After Final submitted by Applicants on June 21, 2004 in response to the Final Office Action of April 19, 2004 would not be entered because the proposed amendments raised new issues that would require further consideration and/or search.

The April 19, 2004 Office Action objected to the specification, specifically to the rewritten paragraph beginning on page 21, line 19. Claims 1-3, 5, 7-9, 16, 21, 23-24, 26, 28-30, 38, 41-43 and 48-49 were rejected under 35 U.S.C. § 102(b) as being anticipated by the article describing the Rocky Mountain Monument & Vault's monument design software described in the article, "Funeral Home Online-Funeral Home Goes High Tech" from the *Utah Prime Times* July 2000 issue, found at <http://www.funeralplan.com/products/fa.html> and at http://www.auroracasket.com/WEB/news_faqs/press_releases/newsoftware.html. Claims 1-21, 23-44, 48-49, and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/00464046 (Barrot et al.) and the *Utah Prime Times* article.

Applicants respectfully traverse the rejections of the Office Action to the extent that they still are maintained. Applicants have nonetheless amended claims 1, 4, 23 and 48

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in deference to the Examiner. Claims 22, 45-47 and 50-52 have been canceled to further the remaining claims unto issuance per the suggestion of the Examiner.

Applicants wish to thank the Examiner for the courtesy extended in the telephonic interview between the Examiner and Applicants' representative on August 24, 2004. During the interview, proposed amendments to the claims to address the art-based rejections were discussed. Based upon the proposed amendments, the Examiner indicated that the proposed amendments overcame the art of record.

To this end, each remaining independent claim has been amended to recite an image of an item capable of being permanently fastened to a funeral item. As discussed during the interview, none of the prior art teaches, suggests or motivates such a feature.

More particularly, claim 1 generally recites a process for guiding a funeral planning session that includes superimposing an overlay image of a correlated item over an image of a funeral item. The correlated item comprises a physical object capable of being permanently fastened onto the funeral item. A planner can then view a composite image of the two items to see how the respective items will look when fastened. The accurate, visual representation of how the physical objects actually appear together thus allows the planner to make other selections based upon the impression of the composite image.

Claim 1 has been rejected as being anticipated by the *Utah Prime Times* article. The *Utah Prime Times* article discloses a process whereby a laser copy of an etched headstone is produced. An artist adjusts lines used for the etching, which is in turn used to

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make a heavy rubber resist material. The rubber resist material is temporarily placed on the headstone while the etching is sandblasted.

The etching is etched out of, not fastened to the headstone. Moreover, the etching does not comprise a physical object (capable of being permanently fastened). Text/artwork on a headstone no more comprises an item separate from the headstone than does, for instance, a granite hue or a chiseled shape selected for the headstone. That is, text that is carved out of a headstone cannot properly be called a physical object. Furthermore, the heavy rubber resist material disclosed in the *Utah Prime Times* article is removed after sandblasting and does not permanently fasten to the headstone. Because the *Utah Prime Times* article does not teach overlaying an image of a correlated item comprising a physical object capable of being permanently fastened onto a funeral item, claim 1 and those claims that depend therefrom are novel over the *Utah Prime Times* article. Consequently, Applicants respectfully request that the 35 U.S.C. §102 rejection of claims 1, as well as of claims 2, 3, 5, 7-9, 16 and 21 be withdrawn.

Moreover, the combination of the *Utah Prime Times* article with Barrot et al. does not render claim 1 obvious, as asserted in the Office Action. Barrot et al. describes a computer that allows users to view images of different funeral products by replacing one web page image with another web page image. As admitted on page 20 of the Office Action, Barrot et al. does not teach forming a composite image by superimposing an overlay image over a base image. The Office Action relies on the *Utah Prime Times* article to remedy this

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deficiency. There is, however, no motivation to combine Barrot et al. with the Utah Prime Times article. Barrot et al. in fact teaches away from the modification of static distributor images at paragraph [0017]. Namely, distributor's images are only accessible in "read only" mode in the Barrot et al. system to preserve data integrity. The Barrot et al. system actually takes precautions to prevent a user from altering a distributor's image of product, such as altering text on a product image as disclosed in the Utah Prime Times article.

Even if the two references could be properly combined, however, there would still be no teaching or suggestion present in Barrot et al., the *Utah Prime Times* article or some combination thereof to superimpose over another an image of a correlated item comprising a physical object capable of being permanently fastened to a funeral item as recited in claim 1. As discussed above, the *Utah Prime Times* article does not teach or suggest overlaying images of a physical funeral objects capable of permanently fastening to each other. Barrot et al. does not suggest overlaying an image with another because it instead replaces one web page image with another. Consequently, claim 1 is non-obvious over a combination of the *Utah Prime Times* article and Barrot et al. Because there is no suggestion, motivation or teaching present in either reference to superimpose an overlay image of a correlated item over a base image of a funeral item, Applicants request reconsideration and allowance of claim 1, as well as those remaining claims that depend therefrom.

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Now turning to independent claim 23, this claim recites in part the concept of superimposing an overlay image of a correlated item capable of attaching to another item over a base image of that other item to form a composite image. Likewise, independent claim 48 recites in part a program configured to superimpose an overlay image of a correlated item over a base image of another item to form a composite image. As such, claims 23 and 48 are allowable for at least similar reasons as discussed above in connection with the rejection of claim 1. Reconsideration and allowance of claim 23 and 48, as well as of claims 24-44 and 49 that depend therefrom are respectfully requested.

Applicants respectfully request that the Examiner enter these amendments on the record pursuant to 37 C.F.R. 1.116(a), as the amendments do not raise any new issues, are fully supported in the specification, drawings and claims as originally filed, and merely place the case in condition for allowance and/or appeal. Applicants respectfully submit that claims 1-44 and 47-51 are now in condition for allowance. Reconsideration and allowance these claims are therefore respectfully requested.

If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner is encouraged to contact the


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undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

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